

REMARKS

This is a full and timely response to the non-final Office Action mailed on October 21, 2004. Claims 102-109 are canceled. Claims 120-121 are newly added. Claims 77-78, 80, 82-87, 89-101, and 110-121 are pending in the present Application. Reconsideration and allowance of the Application and presently pending claims are respectfully requested. Applicants should not be presumed to agree with any statements made in the Office Action regarding the rejections and objections made in the Office Action unless otherwise specifically indicated by the Applicants.

I. Claim of Priority

Applicants are not addressing the validity of all assertions made in the Office Action regarding the priority of this Application. Therefore, Applicants should be not presumed to agree with any statements made in the Office Action regarding the priority of the Application unless otherwise specifically indicated by the Applicants.

II. Response to Claim Rejections Under 35 U.S.C. §112

Claims 104 and 108 stand rejected under 35 U.S.C. §112, first paragraph, for failing to comply with the written description requirement.

Claims 104 and 108 are canceled without prejudice, waiver, or disclaimer. Therefore, rejections related to any of claims 104 and 108 are rendered moot, and Applicants should not be presumed to agree with any statements made in the Office Action regarding any of claims 104 and 108 unless otherwise specifically indicated by Applicants.

III. Response to Claim Rejections under 35 USC § 103

Claims 77, 78, 80, 82-87, 89-103, 105-107, 109-113, and 115-119 stand rejected under 35 USC § 103(a) as being unpatentable over U.S. Patent No. 6,628,302 to *White, et al.* in view of U.S. Patent No. 6,289,346 to *Milewski, et al.*

In order for a claim to be properly rejected under 35 U.S.C. §103, the teachings of the prior art reference must suggest all features of the claimed invention to one of ordinary skill in the art. *See, e.g., In re Dow Chemical*, 837 F.2d 469, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988); *In re Keller*, 642 F.2d 413, 208 U.S.P.Q. 871, 881 (C.C.P.A. 1981).

A. Claim 80

Claim 80 recites:

A method implemented by a television set-top terminal (STT) coupled via a bi-directional communication network to a server located remotely from said STT, said method comprising steps of:

- receiving via a tuner in the STT a video presentation provided by the server;
- outputting by the STT at least a portion of the video presentation as a television signal;
- receiving a first user input associated with a visual scene contained in the video presentation;
- storing information related to said visual scene in a memory of the STT responsive to receiving the first user input;
- outputting by the STT at least another portion of the video presentation as a television signal after the information has been stored in the memory of the STT;
- receiving a second user input configured to request said visual scene in said video presentation after the STT has output the at least another portion of the video presentation;
- outputting by the STT a television signal comprising a portion of said video presentation starting from a location corresponding to said visual scene responsive to the second user input, wherein the location corresponding to said visual scene is identified by the STT using the information related to said visual scene;
- receiving a user input configured to assign a character sequence to said visual scene in said video presentation;***
- storing data corresponding to said character sequence in a memory of the STT responsive to receiving the user input configured to assign a character sequence; and***
- providing said character sequence simultaneously with an image corresponding to said visual scene responsive to subsequent user input;***
- wherein said user input configured to assign a character sequence is received while said video presentation is being presented to said user.***

(Emphasis Added)

i. Previous Office Action

The previous Office Action stated that “the combination of elements claims 76 and 79 further including the limitation of claim 80 wherein the assigning of a bookmark name during the playback of the video-on-demand presentation are not taught, disclosed, or fairly suggested by the art of record.” (Page 21, paragraph 10, Office Action, Paper No. 8). In this regard, claim 80 was amended in the previous response to include the limitation of claims 76 and 79 and thus, put claim 80 in condition for allowance.

ii. White does not disclose or suggest allowing a user to assign a character sequence to a visual scene of a video presentation while the video presentation is presented to the user and storing the character sequence in memory of the STT.

The Office Action (Paper No./Mail Date 041006) admitted that *White* “does not disclose or suggest that the viewer may perform bookmarking operations in conjunction with the distributed programs as is understood in the art.” (Office Action, page 5). In this regard, the Office Action uses *Milewski* to remedy *White*. In addition, Applicants submit that *White* further does not disclose or suggest a method implemented by an STT that includes the steps of “receiving a user input configured to assign a character sequence to said visual scene in said video presentation; storing data corresponding to said character sequence in a memory of the STT responsive to receiving the user input configured to assign a character sequence; providing said character sequence simultaneously with an image corresponding to said visual scene responsive to subsequent user input; wherein said user input configured to assign a character sequence is received while said video presentation is being presented to said user,” as recited in claim 80. More particularly, White (and other cited art as discussed later) does not disclose or suggest allowing a user to assign a character sequence to a visual scene of a video presentation while the video presentation is presented to the user and storing the character sequence in memory of the STT.

iii. The Milewski reference

- a. Milewski does not disclose or suggest allowing a user to assign a character sequence to a visual scene of a video presentation while the video presentation is presented to the user and storing the character sequence in memory of the STT.

Applicants respectfully submit that *Milewski* does not disclose or suggest that a method implemented by a STT that includes the steps of “receiving a user input configured to assign a character sequence to said visual scene in said video presentation; storing data corresponding to said character sequence in a memory of the STT responsive to receiving the user input configured to assign a character sequence; providing said character sequence simultaneously with an image corresponding to said visual scene responsive to subsequent user input; wherein said user input configured to assign a character sequence is received while said video presentation is being presented to said user,” as recited in claim 80.

In fact, *Milewski* discloses as follows:

A bookmarking system is provided that includes a user input device and a network server. A person who is viewing a program, e.g., watching a network news program on television, can bookmark an archived version of that program for future reference. The viewer utilizes the user input device to communicate to the network server the identity of the program of interest. The network server uses the identification information for the program of interest to identify a URL for the archived version of the program. The network server transmits the URL for the archived program to the personal computer of the viewer.

(Emphasis Added, Abstract of *Milewski*)

Milewski apparently discloses that the viewer uses a user input device to have the network server transmit a URL for the archived program to a personal computer to be viewed. *Milewski* does not disclose or suggest allowing a user to assign a character sequence to a visual scene of a video presentation while the video presentation is presented to the user and storing the character sequence in memory of the STT. Consequently, Applicants respect that *Milewski* does not disclose or suggest the above-quoted steps as recited in claim 80. Accordingly, a prima facie case of obviousness cannot be established based on *White* in view of *Milewski*. Applicants respectfully request that claim 80 be allowed and the rejection be withdrawn.

- b. *Milewski and Gibbon* do not disclose or suggest allowing a user to assign a character sequence to a visual scene of a video presentation while the video presentation is presented to the user

In the Office Action, it alleges as follows:

“In connection with the particular composition of the personalized web page comprising the bookmarked segments, the *Milewski et al.* reference is unclear. The reference, however, expressly incorporates by reference the *Gibbon et al.* reference (US Pat No. 6,098,082) (Col. 5, Lines 47-64). The *Gibbon et al.* reference discloses that it is known in the art to ‘provide ... [a] character sequence simultaneously with an image corresponding to ... [a] visual scene.’ Furthermore, the display of a bookmarked image with user defined descriptive information is commonly known in the art, as evidenced by the art of record.”

(Office Action, Paper No./Mail Date 041006, page 7)

Applicants respectfully disagree with the allegation in the Office action. In fact, *Milewski* discloses as follows:

“One method for designating URLs for particular portions of archived programs is to use an algorithm that monitors the “fade outs” in a broadcast program, e.g., the commercial breaks. The algorithm would segment the broadcast program by utilizing the fade outs in the program. Each segment between fade outs would be assigned a unique URL. Therefore, by knowing the time of interest for a particular portion of a program, and therefore knowing when this portion of interest occurred in relation to the start of the program, server 120 could access the segmented portion of the archived program that correlated to the time of interest and retrieve the URL for this segment of the program. This methodology is disclosed in the commonly owned pending U.S. patent application Ser. No. 08/679,976, filed Jul. 15, 1996, titled ‘Method for Providing a Compressed Rendition of a Video Program in a Format Suitable for Electronic Searching and Retrieval.’ This patent application is incorporated by reference herein in its entirety.”

Gibbons apparently discloses that “[a] compressed rendition of a video program is provided in a format suitable for electronic searching and retrieval.” (Abstract). Applicants respectfully submit that *Milewski and Gibbons* do not disclose or suggest allowing a user to assign a character sequence to a visual scene of a video presentation while the video presentation is presented to the user. Accordingly, a prima facie case of obviousness cannot be established based on *White* in view of *Milewski*. Applicants respectfully request that claim 80 be allowed

and the rejection be withdrawn.

B. Claims 96, 110, 112, and 115

Claim 96 includes “store data corresponding to said character sequence in the memory responsive to receiving user input configured to assign a character sequence while said motion video presentation is being presented to said user”. Claim 110 includes “associating by the STT a plurality of respective names with the plurality of locations responsive to a plurality of respective user inputs received by the STT while the motion video presentation was being output by the STT, wherein each of the plurality of respective names comprises a character sequence”. Claim 112 includes “associating a plurality of respective names with the plurality of locations responsive to a plurality of respective user inputs received by the STT while the motion video presentation was being output by the STT, wherein each of the plurality of respective names comprises a character sequence”. Claim 115 includes “said user input configured to assign a character sequence is received by the STT while said motion video presentation is being output by the STT.”

As mentioned with reference to claim 80, Applicants respectfully submit that claims 96, 102, 106, 110, 112, and 115 contain allowable subject matter similar to the allowable elements/limitations of claim 80. Consequently, Applicants respectfully request that claims 96, 102, 106, 110, 112, and 115 be allowed and the rejection be withdrawn.

C. Dependent Claims

Because independent claims 80, 96, 110, 112, and 115 are allowable over the cited art of record, dependent claims 77-78, 82-87, 89-95, 97-101, 111, and 113-114 are allowable as a matter of law for at least the reason that dependent claims 77-78, 82-87, 89-95, 97-101, 111, and 113-114 contain all features and elements of their respective independent base claims. *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988). Accordingly, the rejection to dependent claims 77-78, 82-87, 89-95, 97-101, 111, and 113-114 should be withdrawn for at least this reason, among others.

D. Canceled Claims

Claims 102-109 are canceled without prejudice, waiver, or disclaimer. Therefore, rejections related to any of claims 102-109 are rendered moot, and Applicants should not be presumed to agree with any statements made in the Office Action regarding any of claims 102-109 unless otherwise specifically indicated by Applicants.

IV. Newly Added Claims

Claims 120 and 121 have been newly added. The newly added claims 120 and 121 are adequately supported by the specification. Consideration of new claims 120 and 121 is respectfully requested. The references cited in the Office Action do not disclose, teach, or suggest any of the newly added claims 120 and 121.

Claim 120 is allowable for at least the reason that none of the cited references teach, suggest, or disclose “outputting by the STT information confirming that the visual scene has been bookmarked responsive to receiving the first user input, wherein outputting the video presentation by the STT is not interrupted and the information overlays a minority portion of a television screen being used to display the video presentation.”

Claim 121 is allowable for at least the reason that none of the cited references teach, suggest, or disclose “output information confirming that the visual scene has been bookmarked responsive to receiving the first user input, wherein the video presentation being output is not interrupted and the output information overlays a minority portion of a television screen being used to display the video presentation.”

V. Official Notice, Well-Known, and other similar Languages in the Office Action

Applicants respectfully traverse all Office Notices and Well-known allegations made in the Office Action and submit such should not be considered well-known because the Office Action does not include specific factual findings predicated on sound technical and scientific reasoning to support the conclusions. The Office Action alleges that “the viewer may perform bookmarking operations in conjunction with the distributed programs as is understood in the art.” The Office Action also alleges that “it is known in the art to ‘provide ... [a] character sequence simultaneously with an image corresponding to ... [a] visual scene. Furthermore, the display of book marked image with user defined descriptive information is commonly known in the art, as

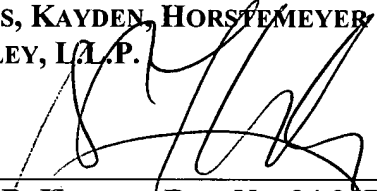
evidenced by the art of record.” The Office Action has taken “Official Notices as to the existence of subscription based video repositories with associated rental access periods that expire.” The Office Action alleges that “the display of a plurality of bookmarked images with associated descriptive information is commonly known in the art.” The Office Action also alleges that “it is known in the art to provide an ‘image corresponding to the first location’ and the ‘second location’”. The Office Action further alleges that “As is well known in the art, a WebTV® terminal is effectively a PC-TV that facilitates both the ability to browse the Internet and watch television programming through an integrated platform.” The Office Action further alleges that there are “well-known browser control functions such as those associated with bookmarking images for later retrieval.” The Office Action further alleges that “it is known in the art to utilize a video segment labeling system wherein ‘at least one of the plurality of names was selected by a respective user input from a list of names provided by the STT.’”

According to MPEP 2144.03, "It would not be appropriate for the examiner to take official notice of facts without citing a prior art reference where the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known." MPEP 2144.03 also states that "If such notice is taken, the basis for such reasoning must be set forth explicitly. The Office Action must provide specific factual findings predicated on sound technical and scientific reasoning to support his or her conclusion of common knowledge." Accordingly, Applicants respectfully traverse the above conclusions and submit that the subject matter noted above should not be considered well known because the Office Action does not include specific factual findings predicated on sound technical and scientific reasoning to support the conclusions. Accordingly, Applicants submit that it has not been shown that the material asserted to be well known is capable of instant and unquestionable demonstration as being well-known.

CONCLUSION

Applicants respectfully maintain that the currently pending claims 77-78, 80, 82-87, 89-101, and 110-121 are in condition for allowance. Should the Examiner have any comments or suggestions that would place the subject patent application in better condition for allowance, he is respectfully requested to telephone the undersigned attorney at (770) 933-9500.

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